



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,745	12/09/2004	Masanori Ogawa	2710-73568/DSD	1305
7590 Donald S Dowden Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036	08/22/2007		EXAMINER LONEY, DONALD J	
			ART UNIT 1772	PAPER NUMBER
			MAIL DATE 08/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,745

Applicant(s)

OGAWA ET AL.

Examiner

Donald Loney

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al (4835026) as presented in the last office action, mailed February 23, 2007.

Horiki et al discloses a masking member 100 of foamed polystyrene with a thickness A wherein thickness of the panel between opposing grooves 102 is 0.30A-0.85A. This equates to the grooves taking up 15-70 % of the thickness of the panel, substantially encompassing the applicant's range of 10-70%. Adhesive 103 is also disclosed on the member per claim 4. Refer to figures 1, 2 and 5-9 along with the Abstract, Summary of the Invention and column 3, lines 25-36. Horiki et al does fail to Specifically disclose a groove width of 0.1-5mm. Horiki et al is silent as to this parameter.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Horiki et al to form the grooves of the width recited motivated by the fact this would only involve a change in size and/or shape of an already known feature (i.e. the grooves have already been shown in the art and both Horiki et al, at column 2, lines 57-12, and the applicant desire to snap the member along said grooves). A change in size and/or shape of an already known feature is generally considered within ordinary skill in the art. See MPEP 2144.04IV. With regards to the expansion ratio being 5-100 times the examiner deems this inherent in the art. EP 0307932, by the same inventor Hokiti et al, is cited as a teaching reference to the fact in that polystyrene foam used for masking members commonly have an expansion ratio of 2-50 times (see column 3, lines 21-28).

5. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al (5206069) as presented in the last office action, mailed February 23, 2007.

Horiki et al discloses a masking member 111 of expanded polystyrene containing grooves 112 on both sides thereof. Refer to figures 4 and 5 along with the corresponding text thereto. Adhesive 114 is also disclosed per claim 4. Horiki et al does fail to specifically disclose the percent thickness of the panel that the grooves occupy (i.e. 10-70%) or the width of the grooves per claim 1. Horiki et al is silent as to these parameters.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Horiki et al to form the grooves taking up the percent thickness of the panel and the specific groove width as recited motivated by the fact this would only involve a change in size and/or shape of an already known feature (i.e. the grooves have already been shown in the art and both Horiki et al, at column 4, lines 14-21, and the applicant desire to snap the member along said grooves). A change in size and/or shape of an already known feature is generally considered within ordinary skill in the art. See MPEP 2144.04IV. With regards to the expansion ratio being 5-100 times the examiner deems this inherent in the art. EP 0307932, by the same inventor Hokiti et al, is cited as a teaching reference to the fact in that polystyrene foam used for masking members commonly have an expansion ratio of 2-50 times (see column 3, lines 21-28).

6. Claims 1 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al (4913786) as presented in the last office action, mailed February 23, 2007.

Horiki et al discloses a masking member 101 of expanded polystyrene containing grooves 102 on both sides thereof. Refer to figures 1-8 along with the corresponding text thereto. Adhesive 104 is also disclosed per claim 4. Horiki et al does fail to specifically disclose the percent thickness of the panel that the grooves occupy (i.e. 10-70%) or the width of the grooves per claim 1. Horiki et al is silent as to these parameters.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Horiki et al to form the grooves taking up the percent thickness of the panel as recited motivated by the fact this would only involve a change in size and/or shape of an already known feature (i.e. the grooves have already been shown in the art and both Horiki et al, at column 5, lines 56-61, and the applicant desire to snap the member along said grooves). A change in size and/or shape of an already known feature is generally considered within ordinary skill in the art. See MPEP 2144.04IV. With regards to the expansion ratio being 5-100 times the examiner deems this inherent in the art. EP 0307932, by the same inventor Hokiti et al, is cited as a teaching reference to the fact in that polystyrene foam used for masking members commonly have an expansion ratio of 2-50 times (see column 3, lines 21-28) and that Horiki et al discloses the member formed by expansion, or foamed, molding (column 4, lines 28-34) as does the applicant. The insert per claim 5 is shown as 172 in figures 22-24. The knob per claim 6 can be considered 173 and the rib per claim 7 can be considered 170 in figure 24. With regards to claim 8, a rib 170 would be around each insert since the inserts 172 are formed with a rib 170 as shown in figure 24.

Response to Arguments

7. Applicant's arguments filed May 29, 2007 have been fully considered but they are not persuasive. In response to applicant's argument that the making member is "used to protect a bolt hole with a part around the periphery of said hole on which a washer is put or to protect a harness hole with a part around the periphery of said hole on which a stand of a plug of said harness hole is put, said part around the periphery of said bolt hole having a corresponding shape fitting exactly to the shape of said washer and said part around the periphery of said harness hole having a corresponding shape fitting exactly to the shape of the stand of the plug", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The applicant argues that a change in shape and/or size can have patentable significance. While this may be true in some circumstances, the examiner believes it is obvious from the prior art, and there is proper motivation to change the shape and/or size as indicated above since the prior art also desires to snap the member along the grooves as does the applicant. Therefore, a specific size of the groove would be obvious to one of ordinary skill in the art since both the prior art and the applicant desire to snap the member along said grooves and the prior art is only silent as to the specific size thereof. The recitation of the edge of the snapped member being "substantially straight" along where the grooves where is a relative limitation which does not structurally distinguish the claimed invention from the prior art. The examiner believes

Art Unit: 1772

the same would be formed in the prior art when looking at applicant's figure 3 and figure 5 in Horiki et al '069 since the grooves appear very similar in structure.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/
Primary Examiner
Art Unit 1772

DJL;D.Loney
08/19/07